ARGUMENTS/REMARKS

Favorable reconsideration of the application in view of the following discussion is respectfully requested.

Claims 37-79 are pending, Claims 37, 62 and 79 having been amended by way of the present amendment.

In the outstanding Office Action, Claims 37-40, 44-57, 59, 61, 62, and 68-74 were rejected under 35 U.S.C. §103(a) as being unpatentable over Prueitt et al. (US Patent No. 5,374,914, hereinafter Prueitt) in view of Elton et al. (US Patent No. 5,036,165, hereinafter Elton); Claims 41-43, 58 and 75-78 were rejected under 35 U.S.C. §103(a) as being unpatentable over Prueitt in view of Elton and further in view of UK Patent 2140195 (hereinafter, GB '195); and Claims 63-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Prueitt in view of Elton and further in view of Donaldson et al. (US Patent No. 5,339,062, hereinafter Donaldson).

In the outstanding Office Action, all of the pending claims were rejected based upon a combination of Prueitt and Elton, and in some cases, a tertiary reference GB '195 or Donaldson is asserted. Applicants maintain their traversal of the rejection based on the proposed combination of Prueitt and Elton for reasons set forth in the Amendment filed October 9, 2001 and the Request for Reconsideration filed April 24, 2002. All of the arguments supporting Applicants' traversal of the rejections set forth in the Amendment filed October 9, 2001 and the Request for Reconsideration filed April 24, 2002 are incorporated

herein by reference.

In the "Response to Arguments" section of the outstanding Office Action, the Examiner rebuts Applicants' argument that the cable described in Elton cannot be formed into coils. The Office Action asserts that this argument "is refuted by the disclosure of Elton et al which states in the abstract and in column 1 line 26 that the conductor may be used in windings in a dynamoelectric machine."[1]

More particularly, the outstanding Office Action relies on the fact that Elton '165 is a divisional application, and therefore is a "patentably distinct" invention from the earlier claimed subject matter in the parent patent, namely Elton '165. The undersigned agrees with this statement. The "invention" of the '165 patent, is described in two claims, namely Claims 1 and 2, which are directed to a "cable" and in no way is descriptive of a winding for use in a machine. Moreover, the '165 patent description of the summary of the invention also makes clear that the embodiment that is the subject of the invention in the '165 is an electrical cable ('165 patent, col. 1, lines 42-50).

The specification of the '165 patent, when properly viewed in context of its parent, namely the '565 patent, describes a cable, as being distinguished from an "insulating conductor" that is used in the winding of a machine. The only thing that the '165 patent makes mention of with regard to a winding in a machine, is the last statement of the abstract. However, as the undersigned attempted to make clear in the past Request for Reconsideration, this abstract is word-for-word the same as the parent, '565 patent, which includes multiple embodiments, some of which are directed to windings in a machine, and

another is directed to a cable, which is the subject of the '165 patent. Accordingly, simply because the '165 patent includes the same abstract as its parent, the '565 patent, based on the above discussion of the history of the '165 patent and the fact that the previous Examiner who placed a restriction requirement on the claims in the '165 patent (directed to a cable) and not a winding in a machine, is ample evidence to show that the '165 patent cannot be fairly viewed as teaching the use of the cable structure on the cover figure of the '165 patent as a winding in a machine.

Furthermore, although the outstanding Office Action asserts that Elton's description in the '565 patent, lines 4-5, about the semiconductor layer being "chopped, mixed with resin and molded or blown on any complex shaped substrate" is not evidence of a cable structure like that shown in the cover figure of the '165 patent as being able to be used as a winding in a machine like that of Elton. It is important to note that there are two semi-conducting pyrolyzed glass fiber layers in the cable of Elton '165. The first layer is identified as number 104 and the second is identified as number 110, both of which are separated by an insulation 106. Accordingly, there is no feasible way to form a "winding" for a machine using chopped glass fibers with resin because by first forming the semi-conducting pyrolyzed glass fiber layer, and later forming the outer semi-conducting layer in the same way, the resin would harden and become too stiff when cured to be threaded through the stator slots. Moreover, in order to "thread" a cable like that shown on the cover of the '165 patent through the stator slots of a motor, the cable must be flexible during the threading operation. However, once the resin is cured, it becomes inflexible.

---

1 See Office Action dated October 24, 2001, at p. 4.

Suppose if the cable shown on the cover of the '165 patent is only partially formed when inserted in the stator slots. In this case, the inner conductors would be wrapped with a semiconductor pyrolyzed glass fiber, and then threaded through the stator slots, and then cured. It is not then possible to include the insulation and the outer semi-conducting layer while the cable winding resides within the stator slot. On the other hand, if the inner semi-conducting glass fiber layer 104 is cured prior to being placed within the stator slots, it will be stiff and not flexible enough to be threaded through the different stator slots.

Accordingly, Applicants traverse the outstanding Office Action's characterization that even if Elton does teach "chopped, mixed with resin and molded or blown on any complex shaped substrate, this process is insufficient to create a winding structure, that has both an inner and outer layer that must remain flexible when being threaded through the stator slots. Accordingly, it is respectfully submitted that the proposed combination of elements, as asserted in the outstanding Office Action, is not enabled by the description in either the '165 patent or the '565 patent.

The independent claims have been amended to be limited to the voltage range of above 36 kV. This amendment to the claims has been made because in a decision on appeal of a related patent application, namely application Serial No. 08/873,019, that if the claims were limited to voltage over 30 kV, for example, then evidence of commercial success would be of greater probative value in determining the obviousness of the claimed invention. Thus the present claims have been amended to be 36 kV and above. This amendment adds no new matter because the specification indicates that the insulation is able to withstand high voltages

in the range of 1kV and upwards (specification page 4, line 23) and can even operate at 800kV and even above (specification page 5, line 4). See In re Wertheim, 191 USPQ 90, (CCPA 1976) which found that specific suggestions of particular values of 36% and 50%, along with an overall range of 25-60% were sufficient to support a subsequent claim in a range of 35-60% that was not literally set forth in the original specification. In this regard, the Court emphasized that literal support is not required to indicate what the artisan would interpret to be clearly part of the originally described invention. Accordingly, no new matter is added.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 39-79, as amended, is patentably distinguishing over the prior art. The present application is therefore

believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Registration No. 25,599
Bradley D. Lytle
Registration No. 40,073
Attorneys of Record

22850

(703) 413-3000 (Telephone)
(703) 413-2220 (Facsimile)

I:\ATTY\BDL\9847\98470058-6XPCT.AM.7-30-03.DOC